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EXAMINER

SHERRER, C

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 04/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/178,840

Applicant(s)

Triantafyllou

Examiner

Curtis E. Sherrer

Group Art Unit

1761

☒ Responsive to communication(s) filed on Jan 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9, 11-14, 21, and 22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9, 11-14, 21, and 22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Again, the claims recite using a heat treated malted cereal whereby said malt is treated "to destroy essentially all B-glucanase activity" or to "sufficiently [] inactivate essentially all B-glucanase contained therein." See further discussion below.

4. Claims 1-9, 11-14, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Applicants have amended the claims to recite the phrase "A process for the production of a cereal wort . . . of more than 2.0%" and the specification only provides for a beer that has this much beta-glucan. Further added was the phrase ""the ingredients employed in the process lacks

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beta-glucanase activity . . .," "sufficient to decrease" (should be --sufficient not to decrease--), and "corresponding source of non-germinated cereal or mixture of cereals" (should be non-germinated corn). Also in claim 5 "lack beta-glucanase activity." Also Claim 22, "lack sufficient beta-glucanase activity . . . before the process is effected" (only occurs when "mainly the insoluble fibers are removed during the process," page 6).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9, 11-14, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The Claims 1 does not provide antecedent basis for the phrase "the ingredients employed in the process."

9. Again, it is unclear on what basis the range "from 10 to 30% by weight" is based. From the specification it appears that it is based on "by volume." Further, it is unclear what weight, i.e., pounds, kilograms, etc., and what volume, i.e., gallons, pints, liters, etc., the range is based on. See further discussion below.

10. Claims 14 and 21 are indefinite because it is not clear how they differ in scope.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 11-14, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindahl (WO95/07628).

13. Lindahl et al teach the production of an oat suspension that equates to Applicant's claimed "wort." The production of the suspension is performed so as to preserve the beta-glucan by avoiding the presence of beta-glucanase. (See page 2, lines 6-20). Inherently, the Lindahl et al final product will have all the claimed attributes because the process is the same.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian (The New Complete Joy of Home Brewing pp. 49, 50, 94 and 95) in view of Lindahl et al.

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16. Papazian teaches the well known steps for producing beer. (See pages 49-50). Further, Papazian teaches the production of beer using grains or starches obtained from grains (page 94).

Papazian does not teach adding oat starch extracts made as claimed. Lindahl et al teach that cited above, specifically, the production of an oat starch extract as claimed. It would have been obvious to one of ordinary skill in the art to use the oat extract of Lindahl et al in the production of beer as taught by Papazian because oat starch extracts are commonly used to make beer. Further, Lindahl et al also teach the benefits of consuming beverages with high amount of beta-glucan.

17. Finally, Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

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Response to Arguments

18. Applicant's arguments filed 01/24/00 have been fully considered but they are not persuasive.

19. In response to the first paragraph rejection, based on lack of enablement, due to the fact that no process steps are provided as to how one of skill in the art would produce a heat treated malted cereal whereby said malt is treated so as to "lack B-glucanase activity." Applicant states that "there is not reasons that any of the other commercial materials noted in the specification, or available in the art, could not be used in the present invention" and that "[t]hose skill in the art would clearly be able to practice the claimed invention even if the particular commercial product noted in the application was discontinued." Applicant provides no support for their statements and therefore said statements are not found persuasive in obviating the instant first paragraph rejection based on enablement.

20. In response to the second paragraph rejection, Applicant states that it "is not understood [why the Examiner is unclear what units of weight or volume are being used] since it does not matter which units are being used as long as those units are consistent." This raises the unanswered question, What weight per volume (not weight per weight) units are consistent? This is the crux of the indefiniteness and Applicant has not supplied the answer and therefore said statement is not found persuasive in obviating the instant second paragraph rejection.

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21. In response to the prior art rejection, Applicants arguments are moot in view of the new prior art rejections.

Conclusion

22. No claim is allowed.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

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25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703)-308-0756. The **fax phone number** for this Group is (703)-305-3602.

26. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, appearing to read "Curtis E. Sherrer".

Curtis E. Sherrer

April 5, 2000